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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,667	01/18/2002	Paul M. Magee	82306JLT	1164

7590

03/25/2003

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EXAMINER

LE, HOA VAN

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 03/25/2003

2

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,667

Applicant(s)

MAGEE ET AL.

Examiner

Hoa V. Le

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 2-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 with respect to the applied species is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 1752

This is in response to the Election filed on 05 March 2003.

I. Applicants elect the invention of Group I, developer composition claims 1-19 without traverse on the record being acknowledged.

II. Applicants elect para-glutamidophenyl disulfide species being acknowledged. Applicants urge that all species of the general formulas I and II should be considered and searched. They are much more than a reasonable number of about three to five species. The request is not found to be convincing.

III. The election of species requirement mail on 30 January 2003 is over stated and taken. Therefore, it is withdrawn and rewritten as followed:

Claims 1-19 are generic to a plurality of disclosed patentably distinct species comprising many possible species of the general formulas I and II. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1752

IV. Applicants' prior art submission filed on 18 January 2002 has been considered.

V. The elected species on the record has been considered and searched. The consideration and search are extended to the applied species. Other non-elected species of the general formulas I and II have not been considered, searched or examined until all of the applied species are overcome.

VI. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 with respect to the applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramp et al (4,254,215).

Kramp et al disclose, teach and suggest a black-and-white developer comprising a sufficient amount of a black-and-white developing agent and a sufficient anti-sludging agent being read within the general formula II (compound No. 9 on column 13) and its analogue (compounds Nos. 6, 7, 8 on column 9; 1, 2 on column 11; 3 on column 12 with respect to a reverse amido group as compared to those being read within the general formula II in accordance with the authority stated in In re Ward, 141 USPQ227, In re Carabateas, 148 USPQ 282 and In re Wetterau, 148 USPQ 499). Please see the whole disclosure of the applied reference, especially at the general formula I from col.2:54 to 18:48 and black-and-white developer in the Examples.

Art Unit: 1752

Since Kramp et al disclose, teach and suggest the known use of the essential and main anti-sludging agent and its analogue in a black-and-white developer in the claims, they are found to be rendered prima facie obvious by Kramp et al to one having ordinary skill in the art at the time the invention was made.

VII. Hofman et al (3,926,632), Lenoir et al (4,141,734), Yamada et al (5,240,823), Komatsu et al (5,510,231), Hirano et al (5,691,108), Sanpei (5,725,998) and Okutsu et al (5,821,040) has about the same teachings and suggestions as those in the above applied references on the record. One or more of them may be next in line to be applied.

VIII. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 703-308-2295. The examiner can normally be reached on 6:30AM-5:00PM, M-TH.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7172 for regular communications and 703-746-7172 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

**HOA VAN LE
PRIMARY EXAMINER**

Hoa Van Le

03/24/03

Hoa V. Le
Primary Examiner
Art Unit 1752